

Appl. No.: 10/767,586  
Amdt. dated 05/18/2007  
Reply to Official Action of April 9, 2007

### **REMARKS/ARGUMENTS**

This Reply is being filed in response to a final Official Action for a Request for Continued Examination (RCE) of the present application. The final Official Action rejects Claims 1-4, 9-12, 17-20, 25, 27 and 29 under 35 U.S.C. § 103(a) as being unpatentable over previously-cited U.S. Patent Application Publication No. 2002/0116268 to Fukuda, in view of newly-cited U.S. Patent Application Publication No. 2002/0087656 to Gargiulo et al. The Official Action then rejects the remaining claims, namely Claims 5-8, 13-16 and 21-23 under 35 U.S.C. § 103(a) as being unpatentable over Fukuda in view of Gargiulo, and further in view of U.S. Patent Application Publication No. 2005/0125561 to Miyaji.

As explained below, Applicant respectfully submits that the claimed invention is patentably distinct from Fukuda, Gargiulo and Miyaji, taken individually or in combination. Accordingly, Applicant respectfully traverses the rejections of the claims as being unpatentable over Fukuda in view of Gargiulo, or as being unpatentable over Fukuda in view of Gargiulo and Miyaji. In view of the remarks presented herein, Applicant respectfully requests reconsideration and allowance of all of the pending claims of the present application. Alternatively, as the remarks presented herein do not raise any new issues or introduce any new matter, Applicant respectfully requests entry of this Reply for purposes of narrowing the issues upon appeal.

As previously explained, Fukuda discloses an information propagation system, device and terminal, and an associated information provision method, for allowing a user to acquire information on an object such as a general-purpose product or relating to an advertisement over a network without having to write the network address. As disclosed, an RF-ID tag storing a uniform resource locator (URL) of a server providing information is attached to a paper-based advertisement. A user carries a personal digital assistant (PDA) including an installed RF-ID reader. Accordingly, the user desiring to obtain this information over the Internet utilizes the PDA to receive the URL from the RF-ID tag installed in that advertisement and access the Internet.

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**A. Claims 1-4, 9-12, 17-20, 25, 27 and 29 are Patentable**

Aspects of the present invention provide a terminal, method and computer program product for interacting with a service provider for accessing a remote service. As embodied in previously presented independent Claim 1, for example, the terminal includes the following:

*a controller configured for actively operating an application, wherein the controller is configured for receiving information from a RF transponder tag or a device adapted to operate as a RF transponder tag at least partially over an air interface, wherein the information includes a service type representing a service offered by the service provider, wherein the controller is configured for contacting the service provider for accessing the service, and thereafter performing a predefined action based upon the service type, the application actively operating on the terminal, and a current state of the application when the controller receives the information, and*

*wherein the controller is configured for alternately performing a first predefined action when the terminal is actively operating an application in a state of receiving data, and performing a second, different predefined action when the terminal is actively operating an application in a state of presenting data, the application being in a state of either receiving data or presenting data when the controller receives the information.*

In contrast to independent Claim 1, neither Fukuda nor Gargiulo (nor Miyaji), taken individually or in any proper combination, teach or suggest performing a predefined action based upon (a) information relating to the service type (received from a RF tag or a device adapted to operate as such), (b) an application actively operating on the terminal, and (c) a current state of the application when the controller receives the information, where the predefined action (first predefined action or second predefined action) differs for different states of the application (receiving data or presenting data).

Applicant submits that the Official Action appears to be applying impermissible hindsight in combining Fukuda and Gargiulo to disclose the claimed invention. *See In Re Dembiczaik*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) (explaining that “[c]ombining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure of a blueprint for piecing together the prior art to defeat patentability -- the essence of hindsight). Moreover, the Official Action appears to be ignoring differences between the claimed invention, as a whole, and the cited references. See MPEP § 2141.02 (“Ascertaining

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the differences between the prior art and the claims at issue requires interpreting the claim language, and considering both the invention and the prior art references as a whole.”).

Applicant notes that independent Claim 1 recites a controller being configured to alternately perform first and second predefined actions depending on the state of an application when the controller receives information from an RF transponder tag, or a device adapted to operate as an RF transponder tag. In rejecting independent Claim 1, the Official Action alleges that Fukuda discloses a controller “configured for alternately performing a first predefined action when the terminal is actively operating an application in a state of receiving data …” Official Action of April 9, 2007, page 3 (emphasis added). The Official Action then concedes that Fukuda does not teach or suggest “performing a second predefined action when the terminal is actively operating an application in a state of presenting data, the application being in a state of either receiving data or presenting data when the controller receives the information.” *Id.* Applicant respectfully submits, however, that in the context of independent Claim 1, the adverb alternately refers to performance of both of the first and second predefined actions. That is, independent Claim 1 clearly recites alternate performance of the first and second predefined actions. Thus, if Fukuda does not teach or suggest performing a second predefined action, then Fukuda cannot reasonably teach or suggest alternately performing a first predefined action since by its very terms, cannot be interpreted without regard to the second predefined action.

Further, Applicant submits that, considering the claim as a whole, performing either the first predefined action or performing the second predefined action is based on the state of an application when the controller receives information from a RF transponder tag or a device adapted to operate as a RF transponder tag. And contrary to the allegations in the final Official Action, nowhere does Gargiulo teach or suggest performing a predefined action when the terminal is actively operating an application in a state of presenting data when the controller receives information from a RF transponder tag or a device adapted to operate as a RF transponder tag. The Examiner may be inclined to allege that Gargiulo is not being relied upon for receiving information from a RF transponder tag or device adapted to operate as such. Applicant again notes, however, that the claim must be considered as a whole, and considering the antecedent basis for the limitation when the controller receives the information, the limitation

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as to the second predefined action, like that as to the first predefined action, requires receipt of information from a RF transponder tag or device adapted to operate as such.

For at least the foregoing reasons, Applicant respectfully submits that neither Fukuda nor Gargiulo (nor Miyaji), taken individually or in any proper combination, teach or suggest a controller configured for alternately performing different predefined actions for different states of an actively operating application when the controller receives information from a RF transponder tag or device adapted to operate as such, as recited by independent Claim 1. Applicant therefore respectfully submits that neither Fukuda nor Gargiulo (nor Miyaji), taken individually or in any proper combination, teaches or suggests independent Claim 1, and by dependency Claims 2-8. Applicant also respectfully submits that independent Claims 9 and 17 recite subject matter similar to that of amended independent Claim 1, including alternatively performing first or second predefined actions for different, presenting or presenting states, of an application actively operating on the terminal. Thus, Applicant respectfully submits that independent Claims 9 and 17, and by dependency Claims 10-16 and 18-23, are patentably distinct from Fukuda and Gargiulo (and Miyaji), taken individually or in any proper combination, for at least the same reasons given above with respect to independent Claim 1.

In view of the foregoing, Applicant respectfully submits that the rejection of Claims 1-4, 9-12, 17-20, 25, 27 and 29 as being unpatentable over Fukuda in view of Gargiulo is overcome.

***B. Claims 5-8, 13-16 and 21-23 are Patentable***

The first Official Action rejects Claims 5-8, 13-16 and 21-23 as being unpatentable over Fukuda in view of Gargiulo, and further in view of Miyaji. Applicant respectfully submits, however, that Miyaji does not cure the defects of Fukuda and Gargiulo, and accordingly, respectfully submit that the claimed invention is patentably distinct from Fukuda in view of Gargiulo, and further in view of Miyaji. More particularly, similar to Fukuda and Gargiulo, and in contrast to independent Claims 1, 9 and 17, and by dependency Claims 2-8, 10-16 and 18-23, Miyaji does not teach or suggest a controller configured for alternately performing different predefined actions for different states of an actively operating application when the controller receives information from a RF transponder tag or device adapted to operate as such. Applicant

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therefore respectfully submit that the claimed invention is patentably distinct from Fukuda, Gargiulo and Miyaji, taken individually or in any proper combination.

For at least the foregoing reasons, Applicant respectfully submit that the rejection of Claims 5-8, 13-16 and 21-23 as being unpatentable over Fukuda in view of Gargiulo, and further in view of Miyaji, is overcome.

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### **CONCLUSION**

In view of the remarks presented above, it is respectfully submitted that all of the claims are in condition for allowance. Accordingly, a Notice of Allowance is respectfully requested in due course. The Examiner is encouraged to contact Applicant's undersigned attorney to resolve any remaining issues in order to expedite examination of the present application. As explained above, no new matter or issues are raised by this Reply, and as such, Applicant alternatively respectfully requests entry of this Reply for purposes of narrowing the issues upon appeal.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



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